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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92049013
Party	Defendant Garten Food Corporation
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Registration No. 2,892,226
Mark: BAREFOOT CONTESSA
Registered: October 12, 2004

CONTESSA PREMIUM FOODS, INC., Petitioner, -against- INA GARTEN LLC, Registrant.	Cancellation No. 92049013

REPLY IN SUPPORT OF MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM, OR ALTERNATIVELY, FOR A MORE DEFINITE STATEMENT AND MOTION FOR SUSPENSION

Registrant respectfully submits this reply in further support of its motion to dismiss, or for a more definite statement. Registrant is mindful that there is no right of reply, but we ask that the Board take this submission under consideration as Applicant believes that this submission will help to correct errors in Petitioner's opposition, and simplify this motion.

Petitioner's entire Opposition to Registrant's Motion to Dismiss (the "Opposition") is based on a legally defective premise: namely, Petitioner's contention that Registrant's Motion to Dismiss under Fed. R. Civ. P. 12(b)(6) (the "Motion") was untimely because Registrant contemporaneously filed an Answer to the Petition. This is legally erroneous. Precedent makes clear that a party may move to dismiss claims under Rule 12(b)(6) while contemporaneously filing an answer, which is precisely what was done here. Thus, there is no basis for converting this motion to one for judgment on the pleadings under Rule 12(c).

Petitioner defends the substantive inadequacy of its Petition for Cancellation only by reiterating the allegations therein and concluding, without legal support, that those allegations are sufficient to withstand Respondent's Motion to dismiss or for a more definite statement. In fact, Petitioner's pleading fails to set forth with particularity a factual basis for its fraud claim as required under Fed. R. Civ. P. 9(b) – Petitioner fails to identify the alleged false representation *and* it fails to identify the goods allegedly not in use at the time of the representation. Further, Petitioner has not identified any harm that Petitioner could have sustained as a result of Respondent's generically alleged conduct. Under the circumstances, the Petition should be dismissed.

In point of fact, the lack of content and specificity in Petitioner's Opposition underscores for Registrant the importance that its motion be granted. Petitioner's failure to respond by more carefully delineating its fraud claim can only mean one of two things. The first possibility is that this Petition has been filed in bad faith with no genuine basis for asserting that Registrant committed fraud on the Patent & Trademark Office. The second possibility is that Registrant believes it has a basis for its claim, but is deliberately withholding the basis so that it can harass Registrant with burdensome discovery requests. After all, the registration at issue contains more than 35 items in the description of goods. Given that Petitioner has absolutely failed to identify which of these goods were allegedly not in use during the four-year prosecution of the registration in question, Registrant is potentially subject to onerous discovery defending its use on all goods in the application.

Petitioner has filed this proceeding on the flimsiest of allegations, all made on information and belief, that Registrant "was not using the subject mark of the '226 Registration on all of the goods identified in the registration at the time it filed the Use-Based application or

when it may have submitted any other subsequent and relevant declaration of use during the prosecution of the application." Petition at ¶ 4. This general articulation of the claim does not meet the stringent requirements for proving fraud under Fed. R. Civ. P. 9(b), and if this proceeding is allowed to move forward on these amorphous and unspecified allegations it will cause great harm to the Registrant. If there is a basis for Petitioner's assertion of fraud, Petitioner should be made to plead it.

ARGUMENT

A. Registrant's Motion Was Properly Filed Contemporaneously With Its Answer

In its opposition, Petitioner concedes that Registrant's Motion was filed "contemporaneously" with its Answer. (Opposition at p. 2.) Case law unequivocally holds that "when the defense of failure to state a claim upon which relief can be granted is raised by means of a motion to dismiss, the motion must be filed before, *or concurrently with*, the movant's answer." TBMP, § 503.01 at 500-278 (emphasis supplied); *Wellcome Foundation Ltd., v. Merck & Co.*, 46 U.S.P.Q.2d 1478, 1480 n.1 (T.T.A.B. 1998) ("A motion under FRCP 12(b)(6) should be filed prior to, or concurrently with, the answer"); *William & Scott, Co. v. Earl's Restaurants Ltd.*, 30 U.S.P.Q.2d 1870, 1873 (T.T.A.B. 1994); ("motion to dismiss under Federal Rule 12(b) must be filed either before or concurrently with the movant's answer"). Thus, there is no merit to Petitioner's claim that Registrant's motion to dismiss must be converted to a motion for judgment on the pleadings because the motion was not filed *before* its Answer.

B. Petitioner's Allegations Fail To State A Claim For Fraud with the Requisite Particularity

Pursuant to the Federal Rules of Civil Procedure, "[i]n alleging fraud or mistake, a party must state with particularity the circumstances constituting fraud or mistake." Fed. R. Civ. P. 9(b); see also *Intellimedia Sports, Inc. v. Intellimedia Corp.*, 43 U.S.P.Q.2d 1203, 1206

(T.T.A.B. 1997) (applying Fed. R. Civ. P. 9(b) and holding that petitioner "failed to state a claim for fraud because it has failed to plead particular facts sufficient to establish" the elements of its fraud claim).

Here, Petitioner fails utterly to provide any specificity to its fraud allegation. In fact, it fails to even identify the alleged misrepresentation that forms the basis of its fraud allegation. Petitioner alleges only that Respondent made "material representations of fact in its application *and/or* during the prosecution of its application, that [respondent] knew or should have known were false... [concerning Respondent's use of its mark] at the time it filed its use-based application *or* when it *may have* submitted *any other* subsequent and relevant declaration of use during the prosecution of the application." Petition, ¶¶ 3-4 (emphases supplied). The application that resulted in Registration No. 2,892,226 at issue in this case was filed in November 2000 and registered in October 2004. Petitioner cannot simply canvas 4 years of correspondence with the USPTO with general allegations of misrepresentation. Such lack of specificity is fatal to Petitioner's pleading under Fed. R. Civ. P. 9(b).

Additionally, Petitioner fails to identify the goods allegedly not in use at the time of the alleged misrepresentations. Respondent's Registration No. 2,892,226, which has been valid and subsisting since 2004, is for more than 35 goods and services. Pursuant to Fed. R. Civ. P. 9(b) and as a matter of policy, it simply *cannot* be sufficient for Petitioner to allege fraud with regard to some limited number of goods without specifying which goods are at issue. To hold otherwise would create a dangerous precedent making a "fraud" cause of action a potent tool for harassment of trademark owners. It would create an opportunity for unfettered discovery on use dates concerning every product covered by a registration, without date limitation. Certainly, this is precisely the sort of procedural abuse against which Fed. R. Civ. P. 9(b) is designed to protect.

Moreover, considering that monetary sanctions are not available in the Trademark Trial and Appeal Board, unless Petitioner is required to allege a specific factual basis for a fraud claim, there is no mechanism to preclude such improperly motivated conduct.

Here, as set forth in the Motion, Registrant believes that Petitioner is using its "fraud" claim precisely for this improper purpose. Certainly, if Petitioner's fraud claim is allowed to stand without Petitioner specifically identifying the product(s) allegedly not in use at the time of the alleged false statements to the USPTO, Respondent will be subject to overbroad and burdensome discovery seeking evidence of Respondent's use of its BAREFOOT CONTESSA mark in connection with each of the more than 35 goods and services identified in the registration – use dating back to as early as 2000, when Respondent filed its application.

For its part, Petitioner entirely failed in its Opposition to address the insufficiency of its pleaded allegations, merely re-stating them and insisting, without any legal support and contrary to the Federal Rules of Civil Procedure, that those allegations are adequate.

In view of the foregoing, in accord with the particular pleading requirement of Fed. R. Civ. P. 9(b), Petitioner's fraud claim should be dismissed. In the alternative, pursuant to Fed. R. Civ. P. 12(e), Petitioner should be required to provide a more definite statement of its fraud claim, including a good faith factual basis for the claim that identifies both (a) the misrepresentation in issue and (b) the goods allegedly not in use at the time of the alleged misrepresentation.

C. Petitioner's Fails to Sufficiently Allege Standing

Finally, Petitioner's allegations of harm are insufficient to establish standing. At the pleading stage, Petitioner must "allege facts sufficient to show a real interest in the proceeding, and a reasonable basis for its belief of damage. To plead a real interest, plaintiff must allege a direct and personal stake in the outcome of the proceeding. The allegations in support of plaintiff's belief of damage must have a reasonable basis in fact." TBMP, § 309.03 at 300-145-46 (quotations omitted) (citing, *inter alia*, *Ritchie v. Simpson*, 50 U.S.P.Q.2d 1023, 1025-27 (Fed. Cir. 1999)).

In its Petition for Cancellation, Petitioner asserts no factual basis for its conclusory allegation that it has been injured. Nowhere has Petitioner alleged facts that, if proven, would substantiate its alleged injury. Accordingly, Petitioner's fraud claim should be dismissed or, at least, pursuant to Fed. R. Civ. P. 12(e), Petitioner should be required to provide a more definite statement of its alleged injury.

Dated: New York, New York
May 23, 2008

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